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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,167	03/30/2001	Ellen Isaacs	2000-0027-CIP	9243

7590 08/16/2004
Samuel H. Dworetsky
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Middletown, NJ 07748-4110

EXAMINER

NGUYEN, TRONG NHAN P

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,167

Applicant(s)

ISAACS ET AL.

Examiner

Jack P Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are being examined.

Drawings

2. The drawings are objected to because of the following:
 - In figure 2, the icons are denoted by element 140 while the specification denotes them as element 134.
 - In section [0035] of the spec, the spec shows step 136 in fig. 3. However, the drawing fails to show such step.
 - In section [0057] of the spec, message recipient is denoted as elements 610 and 620. However, fig. 6 denotes message recipient as element 620.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-8, 10-17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Maurille, 6,484,196 (hereafter Maurille).

5. As per claim 1, Maurille teaches a method for communicating via instant messages, the method comprising:

receiving a message from a message sender designated for at least one message recipient (fig. 3A, element 3.2, col. 10, lines 5-21);

determining when the message is received by the at least one message recipient, wherein a determination that the message is received is confirmed by a message acknowledgement (F4B, E420-1, C13, L29-44. *When the recipient respond the sent message, an acknowledgement is being sent back to the sender indicating that the message has been received and read by the recipient*); and

providing a status update for the message sender, the status update comprising a visual representation of the message having a first appearance when the message is pending and a second appearance when the message is received by the at least one message recipient (C13, L12-55. *When the sender sends a message to the recipient, the message is in the unread (pending) mode that is visually shown in a particular color (each message type has its own distinctive color associated to it.) After the recipient has read and responded to the message, the status of the message is updated to reflect the changes. The color of the message then changes to a different color to indicate the updated message status.*)

6. As per claim 2, Maurille teaches the method of claim 1, wherein determining when the message is received by the at least one message recipient comprises:

assigning a unique sequential number to the message (F3B, E142, C11, L11-24. *Each message is denoted by their message id (MsgID) and the MsgIDs are assigned in a sequential order in a threaded Instant Messaging (IM) conversation*); and updating a message listing, wherein the message is identified by the unique sequential number in the message listing (C11, L65-67; C12, L1-13. *After the recipient has read and responded to the message, the message listings of both the sender and recipient get updated with the new status of the message.*)

7. As per claim 3, Maurille teaches the method of claim 1, wherein determining when the message is received by the at least one message recipient comprises: assigning a unique sequential number to the message (F3B, E142, C11, L11-24. *See additional information in paragraph 6 above*); and providing an acknowledgement to the message sender when the message is received by the at least one message recipient, the acknowledgement identifying the unique sequential number of the message (F4B, E420-1, C13, L29-44. *See related information in P5 & P6 above.*)

8. As per claim 4, Maurille teaches the method of claim 3, wherein the acknowledgement is also assigned a unique sequential number (F3B, E142, C11, L17-24; C13, L29-44. *Examiner interprets an acknowledgement is a type of message and all messages (including acknowledgements) are denoted by their message ids (MsgIDs). The MsgIDs are assigned in a sequential order in a threaded Instant Messaging (IM) conversation.*)

9. As per claims 5, 6, 7, Maurille teaches the method of claims 1 and 5, wherein the visual representation is text from the message that alternates between a first color in the first appearance and a second color in the second appearance (C13, L12-55. See *additional information in P5.*)

10. As per claim 8, Maurille teaches the method of claim 1, wherein determining when the message is received by the at least one message recipient comprises: providing an acknowledgement to the message sender when the message is received by the at least one message recipient (F4B, E420-1, C13, L29-44. See *P5 for more details*), the acknowledgement identifying the unique sequential number of the message (C11, L17-24. See *P8 for more details*), wherein the visual appearance of the status update before the acknowledgement is received is provided in a first configuration and in a second configuration once the acknowledgement is received (C13, L12-28. See *P5 for more details*).

11. As per claim 10, Maurille teaches a method for establishing instant messaging communications between a message originator and one or more message receivers, the method comprising:
receiving an instant message from the message originator (F3A, E3.2, C10, L5-21);

providing the instant message from the message originator to the one or more message receivers specified by the message originator (F3B, U007, U019, U027, E142, C11, L11-17. *A sender can send the IM message to a plurality of users on the network*); and providing an update of a local message display of the message originator once the message originator's instant message is received by the one or more message receivers (C11, L65-67; C12, L1-13. *See P6 for more details*), wherein the local message display is provided in a pending configuration before the message is received by the one or more message receivers and the local display is provided in a received configuration once the message is received by the one or more message receivers (C13, L12-28. *See P5 for more details*), the receipt of the message being acknowledged by a message acknowledgement sent by the one or more message receivers (F4B, E420-1, C13, L29-44. *See P5 for more information.*)

12. As per claim 11, Maurille teaches the method of claim 10, wherein the local message display provides a display of the message text in the pending and received configurations (C13, L12-28. *See P5 for more information.*)

13. As per claim 12, Maurille teaches the method of claim 10, further comprising: determining when the instant message is received by the one or more message receivers (F4B, E420-1, C13, L29-44. *See P5 for more information.*)

14. As per claim 13, Maurille teaches The method of claim 12, wherein determining

when the instant message is received by the one or more message receivers comprises: establishing a message listing for the message sender and the one or more message receivers (F1, E142, C8, L21-26. *Each user has an individual message record (listing) to keep track and manage their own messages. All messages and respective their statuses (unread, read, etc.) are kept in this message record listing. When there is a change in the status of a message, the message listing gets updated to reflect the changes*), wherein the message listing updated based on an acknowledgement of the message being received by the one or more message receivers (C11, L65-67; C12, L1-13. *See P6 for more details.*)

15. As per claim 14, Maurille teaches the method of claim 13, wherein the message listing prohibits duplication of the instant message on the one or more message receivers' devices (C11, L44-67; C12, L1-13. *After receiving the message from the sender, the server sends a message alert (MsgAlert) to the receiver. When the receiver responded to MsgAlert with an OK, the server then sends the message to the receiver. This prohibits the receiver from receiving message duplicates.*)

16. As per claim 15, Maurille teaches the method of claim 13, wherein each message in the message listing is identified by a unique serial number (F3B, E142, C11, L11-24. *See P6 for more details.*)

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17. As per claim 16, Maurille teaches a computer readable medium having instructions stored thereon for executing the steps comprising:
creating a message listing of one or more pending messages (C8, L21-26. *See P14 for related details*);
providing a message indicator in a first appearance for the one more pending messages (C13, L12-28. *See P5 for related details*);
updating the message listing based on the receipt of message acknowledgements (C11, L65-67; C12, L1-13. *See P6 for more details*); and
providing the message indicator in a second appearance for the one or more pending messages as the pending messages are deemed to be received (C13, L12-28. *See P5 for related details*).

18. As per claim 17, Maurille teaches the computer readable medium of claim 16, wherein the first appearance and the second appearance correspond respectively to a first coloration and a second coloration of the message (C13, L12-28. *See P5 for related details*).

19. As per claim 20, Maurille teaches the method of claim 16, further comprising:
compiling a message listing of all pending messages wherein the message listing is updated when a message is acknowledged as received (C11, L65-67; C12, L1-13. *The message record listing comprises listings of all types of messages (including pending,*

read, etc.) in the system, and the message listing is updated when there is a change in the status of a message (see P14 for more details.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maurille in view of Ogle et al, 6,654,790 (hereafter Ogle).

21. As per claims 9, 18, and 19, Maurille does not explicitly teach the method of claims 1 and 16, further comprising: sending the message to the at least one message recipient to a plurality devices used by the message recipient and determining the location of one or more intended recipients of the pending messages.

Ogle teaches a method of sending the message to a user who may use a plurality of devices as alternate means of receiving the message (F2, E10, F3, E301, E302, E303, abstract, C2, L55-67; C3, L9-28; C8, L18-38. *A user can receive the message via a plurality of devices through which he has registered for. In addition, he may also*

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choose the mechanism (devices) and locations he prefers the message to be delivered. For example, if he's traveling or at home, he may want to have messages delivered to him via pager, cell phone, or pda.)

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Maurille by including alternative means (devices) for which messages can be delivered at a plurality of locations (F2, E10, F3, E301, E302, E303, abstract, C2, L55-67; C3, L9-28; C8, L18-38). One of ordinary skill in the art would have been motivated to combine the teachings of Maurille and Ogden to allow the user have access to important messages (data) from a plurality of devices at a plurality of locations that is most convenient to the user.

22. As per claim 19, Maurille teaches the method of claim 18, further comprising: removing a message from the message listing when the message is deemed received by the message acknowledgement (C11, L65-67; C12, L1-13. *Once an acknowledgement has been received by the server, the server will forward the pending message to the receiver, thus removing the message from the pending status of the message listing and update the status of the message in both the message listings of the sender and receiver (see P5 for more details).*

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- System and Method For Conducting Focus Groups Using Remotely Loaded Participants Over a Computer Network – Davis, 6,256,663
- Gamer Server For Use in Connection With a Messenger Server – Kirmse et al, 6,699,125
- Group Contacting System and Recording Medium For Storing Computer Instructions For Executing Operations of The Contact System – Katuta et al, 6,714,965
- System and Method For Interconnecting Secure Rooms – Estrada et al, 6,732,148
- Method and System For Instant Messaging Across Cellular Networks and a Public Data Network – Carey et al, 6,714,793


24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack P Nguyen whose telephone number is (703) 605-4299. The examiner can normally be reached on M-F 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jpn



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